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REMARKS

In the last Office Action, claims 1, 2, 4-8, 12-15, 17-21 and 24-26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Zip Coupons in view of Storey and Excite. The Examiner stated that Zip Coupons discloses the claimed structure including the consumer units, communication means, memory for storing retail outlet data and coupon data, a data processing unit, first means for transmitting a list of individually-selectable participating retail outlets, second means responsive to the selection of a retail outlet for transmitting a list of individually-selectable goods offered for sale by the selected retail outlet, and third means for transmitting coupons corresponding to selected goods.

The Examiner further stated that while Zip Coupons does not explicitly show that the participating retail outlets are individually selectable by the user, Storey discloses this concept at col. 3, lines 7-60.

Claims 3 and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Zip Coupons in view of Storey and Katz et al. The Examiner stated that Katz et al.

disclose that the communications medium comprises a public telephone network and means for acquiring caller ID data to identify the geographical location of the consumer units.

Claims 9-11 and 22-23 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zip Coupons in view of Storey, Excite and Burke. The Examiner stated that Burke discloses data representative of the physical layout of a retail outlet, including aisle location of goods offered for sale.

By the present response, claim 1 has been amended to incorporate the subject matter of dependent claim 10, which has been canceled. Claim 25 has been amended to delete the recitation pertaining to coupon distribution and to further recite that the aisle location of selected goods is transmitted to the consumer unit.

Applicants respectfully traverse the prior art grounds of rejection.

The amended claims recite a system (and method) in which plural consumer units are provided for receiving information over a network from a server which stores and transmits files containing store data, inventory data, location data, and (optionally) coupon data, and further set forth a particular process for the distribution of shopping lists and optionally coupons containing a series of clearly defined steps.

More specifically, the claims require: (1) establishing a link between a consumer unit computer and a coupon server computer over a communications medium; (2) transmitting from the coupon server to the consumer unit a list of participating retailers; (3) displaying the list of retailers on the consumer unit so that the consumer may select one of the displayed retailers; (4) transmitting from the coupon server to the consumer unit a list of the inventory of goods of a selected retailer; and (5) in response to the selection of one or more items of goods by the consumer, transmitting from the coupon server to the consumer unit a file containing a list of the selected goods identifying the aisle location of the selected goods in the selected retail outlet and optionally coupons for the selected goods.

Applicants respectfully submit that the claims recite subject matter that is not rendered obvious by the cited prior art.

Preliminarily, while Zip Coupons discloses a coupon distribution system, it does not, either alone or in combination with Storey and Excite, disclose a system in which a consumer unit is used to: (1) obtain and display a list of participating retail outlets; (2) allow a consumer to select a particular retail outlet from the displayed list; (3) display a list of the inventory of goods offered for sale by the

selected retail outlet; (4) allow the consumer to select one or more of the displayed goods; (5) obtain a shopping list identifying the physical location (aisle number) of the selected goods in the selected retail outlet; and (6) optionally obtain coupons for the selected goods after making the foregoing selections. Zip Coupons merely discloses the concept of targeted coupon distribution and fails to disclose all of the foregoing limitations. Zip Coupons merely discloses that coupons for certain generic product categories (not retail outlets) can be accessed by a consumer based on zip code. Zip Coupons does not disclose the structure or steps of independent claims 1, 14 and 25 pertaining to the generation of a shopping list by downloading a list of user-selectable retail outlets, downloading a list of user-selectable goods available at a selected retail outlet, and downloading a shopping list containing the selected goods and aisle locations of the goods at the selected retail outlet. Zip Coupons does not address the identification of retailers and is directed to zip codes and category of goods.

Accordingly, Zip Coupons does not disclose or suggest the structure or steps of claims 1, 14 and 25, each of which requires that the server transmit to a consumer unit, in response to the selection by the consumer of one of the displayed retailers, a list of the inventory of goods of a

selected retailer and displaying the list on the consumer unit.

Neither Storey nor Excite cure the foregoing defects of Zip Coupons. Neither Storey nor Excite disclose that a server downloads a list of participating user-selectable retail outlets, a list of user-selectable goods sold by a selected retail outlet, and a shopping list containing a list of the selected goods and aisle locations of the selected goods at the selected retail outlet.

The claims recite a system and method in which a coupon server transmits and displays on a consumer unit a file containing a list of participating retail outlets for selection of a retail outlet by a consumer and another file containing the inventory of goods sold at the selected retail outlet. The server is responsive to consumer selections to distribute a list of selected goods identifying the aisle location of the selected goods in the selected retail outlet and optionally for distributing coupons based on the selected goods. Neither Zip Coupons, Storey nor Excite contain corresponding disclosure or steps.

Applicants further respectfully submit that the independent claims patentably distinguish over the combined references to Zip Coupons and Burke. Burke was cited as disclosing data representative of the physical layout of the

participating retail outlets indicating the location of the goods offered for sale, and means responsive to the selection of one or more items of goods by the consumer to transmit a file for display on the display monitor of the consumer unit containing data identifying the location in the selected retail outlet of the goods selected by the consumer.

Applicants respectfully note, however, that the independent claims recite that the file transmitted from the coupon server to the respective consumer unit in response to the selection of one or more items of goods by the consumer contains data identifying the aisle location in the selected retail outlet of the goods selected by the consumer.

Stated otherwise, the claims do not recite a virtual shopping store of the type disclosed by Burke, and instead recite a method in which a list of goods selected by a consumer, or a consumer's shopping list, is transmitted to the user by the coupon server in a format which identifies the consumer's selected goods along with the aisle location in the selected retail outlet of the selected goods, and optionally coupons for the selected goods.

Burke, on the other hand, discloses the generation of a simulated warehouse on a monitor which enables consumers to purchase goods. Burke does not disclose an online representation of an actual retail outlet, but discloses an

entirely simulated store. Burke clearly does not disclose the production of a list of selected goods which identifies the aisle locations in the selected actual retail outlet at which those goods are located. According to the claimed invention, consumers do not shop at a virtual supermarket, but select goods online and receive a list of the selected goods along with a shopping list identifying the aisle location in the actual retail outlet at which the goods are located. The consumer physically visits the selected store after obtaining the list identifying the aisle location and optional coupons for the selected goods. This is markedly distinct from the Burke reference.

Accordingly, applicants respectfully submit that the subject matter of claims 1-26 is markedly distinct from that disclosed in Zip Coupons, Storey, Excite and Burke, and that the rejection based on these references Burke is in error and should be withdrawn.

A claim rejection based upon obviousness under 35 U.S.C. §103(a) must be supported by evidence establishing the obviousness of each and every limitation of a rejected claim. This burden cannot be established by a cited reference which discloses some of the limitations of a rejected claim, and an unsupported conclusion that others would have obvious. There must be some teaching, reason, suggestion, or motivation found

in the prior art to make a combination or modification which renders an invention obvious within the meaning of 35 U.S.C §103(a). See, e.g., Symbol Technologies, Inc. v. Opticon, Inc., 935 F.2d 982, 989, 18 USPQ2d 1885 (Fed. Cir. 1991).

The Examiner must not only demonstrate that this teaching exists in the prior art, but that it would teach all limitations of the claim. Thus, the citation of two or more reference which when combined do not yield each limitation of a rejected claim is not a satisfactory ground of rejection. Stated otherwise, in rejecting a claim as obvious under 35 U.S.C §103(a), the Examiner cannot simply rely on a combination of references that teach some limitations of the claim, and make mere conclusory allegations that the combination teaches others as well.

In the instant case, the Examiner has not met his burden of establishing a prima facie case of obviousness for the reasons discussed above. Zip Coupons and Burke fail to disclose or suggest the list of participating retail outlets. Neither of these references allows the consumer to select a participating retail outlet and obtain a list of the goods offered for sale by the selected retail outlet. Neither reference discloses or suggests the transmission of a shopping list identifying the goods selected by the consumer from the

list of goods offered for sale along with the aisle location of the selected goods in the selected retail outlet.

Burke fails to disclose or suggest the user-selectable lists of participating retailers and inventories of goods, as recited by amended claim 1, or the transmission of a customized list of selected goods along with their physical location in the selected retail outlet, as recited by the independent claims. Accordingly, the continued rejection of these claims under §103(a) would not satisfy the standards discussed above. As stated by the Board of Appeals in Ex Parte Clapp, 227 USPQ 972, 973 (BPAI 1985):

... To support the conclusion that the claimed combination is directed to obvious subject matter, ... the references must expressly or impliedly [disclose or suggest] the modifications urged by the examiner to have been obvious.

The same situation exists here. There is nothing in the references that would expressly or impliedly teach or suggest the use of the user-selectable lists of the independent claims.

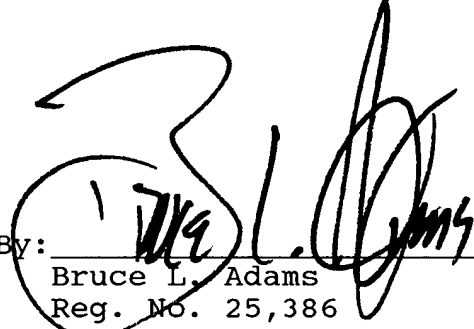
For the foregoing reasons, applicants respectfully submit that claims 1-9 and 11-28 patentably distinguish over the prior art of record.

In view of the foregoing amendments and discussion, the application is now believed to be in condition for

allowance. Accordingly, favorable reconsideration and allowance of the claims are most respectfully requested.

Respectfully submitted,


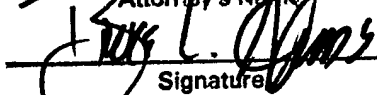
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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claim 10 has been canceled without prejudice or admission and claims 1, 8, 25 and 26 have been amended as follows:

1. (Twice Amended) A coupon distribution system comprising:

a plurality of consumer units each operable by a consumer and each comprising a display monitor, a memory for storing data to be displayed on the display monitor, a data processing unit connected to the display monitor and the memory and having communication means connectable over a communication medium to at least a coupon server, and a user input device to permit a consumer to make one or more selections from choices displayed on the display monitor;

a coupon server located remotely from the consumer units and comprising a memory for storing first data corresponding to one or more participating retail outlets, the first data including data for identifying each of the retail outlets by name and inventory of goods offered for sale, and second data containing coupon data used for generating electronic discount coupons for selected goods, and a data processing unit having communication means connectable over



the communication medium to the consumer units, the coupon server further comprising

first means responsive to a connection with a respective consumer unit to transmit for display on the display monitor of the respective consumer unit a first file containing a list of participating retail outlets which may be individually selected by the consumer using the user input device of the respective consumer unit,

second means responsive to the selection of one of the retail outlets displayed on the display monitor of the respective consumer unit by the consumer to transmit to the respective consumer unit a second file containing first data corresponding to the selected retail outlet for display on the display monitor of the consumer unit, the second file containing a list of the inventory of goods offered for sale by the selected retail outlet, and the displayed inventory of goods being individually selectable by the consumer using the user input device, [and]

third means responsive to the selection of one or more items of goods by the consumer to transmit a third file for display on the display monitor of the respective consumer unit containing data corresponding to the selected goods, the third file containing electronic coupons corresponding to one or more of the selected goods; and

fourth means responsive to the selection of one or more items of goods by the consumer to transmit a fifth file for display on the display monitor of the consumer unit containing data identifying the aisle location in the selected retail outlet of the goods selected by the consumer.

8. (Amended) A coupon distribution system according to claim 7; wherein the coupon server is located remotely from the point-of-sale unit, and further comprises fifth [fourth] means for transmitting to the point-of-sale unit a fourth file containing the identity of goods offered for sale by the retail outlet at which the point-of-sale unit is located, the goods being individually selectable by the consumer using the user input device; wherein the third means of the coupon server is responsive to the selection of one or more items of goods by the consumer to transmit the third file for display on the display monitor of the point-of-sale unit containing second data corresponding to the selected goods, the third file containing electronic coupons corresponding to one or more of the selected goods.

25. A method for the generation of a shopping list [distribution of coupons] over a network, comprising the steps of:

using a first computer operated by a consumer to establish a connection with a second computer [operated by a coupon distributor] over a communication medium;

using the second computer to acquire identifying indicia for identifying the geographical location of the first computer;

in response to the connection between the first and second computers, selecting from a list of participating retail outlets stored in the second computer one or more participating retail outlets in the geographical vicinity of the first computer;

transmitting from the second computer to the first computer a first file containing the selected one or more participating retail outlets, each of which may be individually selected by the consumer using an input device;

displaying on the first computer the list of the one or more selected participating retail outlets contained in the first file;

in response to a selection by the consumer of one of the displayed retail outlets, transmitting from the second computer to the first computer a second file containing data corresponding to the selected retail outlet including a list of the inventory of goods offered for sale by the selected retail outlet [and data representative of the physical layout

of the selected retail outlet indicating the physical location of the goods offered for sale];

displaying the list of the inventory of goods offered for sale by the selected retail outlet on the first computer such that the displayed inventory of goods are individually selectable by the consumer using the first computer so that the consumer may select [enter a shopping list into the first computer by selecting] one or more items of goods the consumer intends to purchase at the selected retail outlet; and

in response to the selection of one or more items of goods by the consumer, transmitting from the second computer to the first computer a file containing [electronic coupons corresponding to one or more of the selected goods and a file containing] data identifying the physical aisle location in the selected retail outlet of the goods selected by the consumer.

26. (Amended) A method for the generation of a shopping list [distribution of coupons over a network] according to claim 25; wherein the communication medium comprises the Internet, the first computer comprises a client computer and the second computer comprises an Internet host computer.